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**REMARKS**

Claims 1-26 are all of the claims presently pending in the application. The claims have not been amended by the present Response.

Claims 13 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 1-11, 13-15, 17, 19 and 22-26 stand rejected under 35 U.S.C 102(b) as being anticipated by Kamata et al. (U.S. Patent Application No. 6,814,224) (hereinafter "Kamata"). Claims 1-3, 11-14 and 19-26 stand rejected under 35 U.S.C. 102(e) as being anticipated by Grynkevich et al. (U.S. Patent No. 6,881,351) (hereinafter "Grynkevich"). Claims 12, 20 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kamata in view of Grynkevich. Claim 16 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kamata or Grynkevich in view of Klemmer et al. (U.S. Patent No. 6,849,349) (hereinafter "Klemmer"). Claim 18 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kamata.

These rejections are respectfully traversed in the following discussion.

**I. THE 35 U.S.C. § 112, SECOND PARAGRAPH, REJECTION**

Claims 13 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Applicants respectfully submit, however, that the Examiner is incorrect.

The Examiner, in his rejection, alleges that the phrase "a magnetic device" is indefinite. Specifically, the Examiner inquires "[w]hat is the difference between the magnetic device produced by claim 1 and that of claim 13?" (see Office Action dated October 28, 2005 at page 4).

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Applicants respectfully submit that claim 1 does not recite "producing a magnetic device". Indeed, claim 1 clearly recites "a method of patterning a magnetic thin film". Claim 13 further limits the subject matter of claim 1 by claiming the additional step of producing a magnetic device after the limitation of "transforming a portion of the magnetic thin film to be non-magnetic and electrically insulating using a chemical formation". A person reasonably skilled in the art would clearly understand what is meant by the phrase "producing a magnetic device" and that "producing a magnetic device" is clearly different from "transforming a portion of the magnetic thin film to be non-magnetic and electrically insulating using a chemical formation".

Therefore, in view of the above traversal arguments, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

## II. THE DECLARATION UNDER 37 C.F.R. § 1.131

### A. The Prior Art References Claim the Rejected Invention

The Examiner alleges that Applicants' § 1.131 Declaration is ineffective to overcome Klemmer and Gryniewich because Klemmer and Gryniewich claim the rejected invention. Applicants respectfully submit, however, that the Examiner is clearly incorrect.

That is, in accordance with M.P.E.P. § 2138.01, "the term 'same patentable invention' encompasses a claim that is either anticipated by or obvious in view of the subject matter recited in the patent claim". Applicants submit that the Examiner, when alleging that the prior art references claim the same patentable invention, must consider only the features recited in the claims of the prior art references.

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Applicants respectfully submit that the claimed invention (e.g., as defined by claims 1-26), recites a method of patterning a magnetic thin film. Claims 1-11 (i.e., all of the claims) of Klemmer recite a “magnetic recording medium”. The claims of Klemmer are clearly directed to a device and do not even recite a method, let alone claim the method recited in claim 1-26 of the claimed invention.

Indeed, the claimed invention of Klemmer is directed to a completely different statutory class of invention from the claimed invention of claims 1-26 of the Application. Therefore, Klemmer clearly does not claim the same invention as the claimed invention of claims 1-26 of the Application.

Moreover, Applicants submit that Grynkewich does not claim the same invention as claims 1-26 of the Application. Indeed, the Examiner merely alleges that “Grynkewich ‘351 (see claim 10) [is] claiming the ‘same patentable invention’ namely, transforming a portion of magnetic thin film into non-magnetic, insulative using a chemical transformation” (see Office Action dated October 28, 2005 at page 12).

Even assuming, however, that the Examiner is correct, the Examiner has merely alleged that Grynkewich claims the claimed invention of claim 1. For a prior art reference to claim the “same patentable invention” as the claimed invention of the Application, the prior art reference must claim each and every limitation of the claimed invention of claims 1-26. Additionally, to claim the same patentable invention as the claimed invention of the Application, the claims of Grynkewich must not include any additional claim limitations not claimed by the claimed invention of claims 1-26.

Therefore, if the Examiner wishes to maintain his allegations that Klemmer and Grynkewich claim the same patentable invention as the Application, Applicants request

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the Examiner to specifically point out which claims of the Klemmer and Grynkewich claim the same invention of each of claims 1-26 of the claimed invention of the Application.

Therefore, Applicants respectfully submit that neither Klemmer nor Grynkewich claim the claimed invention of claims 1-26 of the Application.

#### **B. Diligence**

The Examiner alleges that the evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice.

However, Applicants have not attempted to establish a showing of diligence after March 29, 2002. That is, the evidence provided in the Declaration filed on August 23, 2005 establishes an actual reduction to practice. Therefore, there is no requirement for Applicants to establish diligence.

Therefore, Applicants respectfully submit that the Examiner's allegations regarding diligence are considered irrelevant.

#### **C. Reduction to Practice**

The Examiner alleges that the evidence submitted is insufficient to establish a reduction to practice. Specifically, the Examiner alleges that "[t]here is no evidence that a working device has been made prior to March 29, 2002" (see Office Action dated October 28, 2005 at page 3) (emphasis added by Applicants). The Examiner, however, is clearly incorrect.

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That is, Applicants respectfully submit that there is no requirement for Applicants to provide evidence that a working device is made. Indeed, the claimed invention of claims 1-26 recite a “method of patterning a thin film”. The M.P.E.P. states that “a party seeking to establish an actual reduction to practice must satisfy a two-prong test: (1) the party constructed an embodiment or performed a process that met every element of the interference count, and (2) the embodiment or process operated for its intended purpose” (see M.P.E.P. § 2138.05) (emphasis added by Applicants). The claimed invention recites a method, not a device. Therefore, to establish an actual reduction to practice, the evidence provided only needs to show that Applicants performed a process that met every element of the claimed process.

Applicants respectfully submit that the evidence provided in the 1.131 Declaration clearly provided sufficient evidence to demonstrate that Applicants had (1) performed the claimed process and (2) that the process operated for its intended purpose prior to March 29, 2002.

#### D. Conclusion

Applicants respectfully submit that the Declaration filed on August 23, 2005 is clearly effective to overcome the Examiner’s prior art rejections based on Kamata, Klemmer and Grynkewich. Therefore, the Examiner is respectfully requested to withdraw his prior art based rejections.

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### III. THE PRIOR ART BASED REJECTIONS

#### A. The Kamata Reference

Claims 1-11, 13-15, 17, 19 and 22-26 stand rejected under 35 U.S.C. 102(b) as being anticipated by Kamata. Additionally, claim 18 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kamata.

Applicants respectfully submit, however, that Kamata can be removed by swearing behind the filing date of the Kamata reference.

The Kamata reference was filed on March 29, 2002 and issued as a U.S. Patent on January 11, 2005. Thus, the earliest effective prior date of the Kamata reference is March 29, 2002, its U.S. filing date. Applicants submit that the claimed invention was invented and reduced to practice prior to March 29, 2002. Therefore, the Kamata reference is removed by the previous filing of a Declaration under 37 C.F.R. 1.131.

This Declaration under 37 C.F.R. 1.131 (and Exhibit 1 – The Inventor's Original Write-Up of the Invention, Exhibit 2- The Original IBM Internal Disclosure Document, and Exhibit 3 – The MDA Invention Review Board Disclosure) showed invention and actual reduction to practice of the subject matter of the present application prior to the filing date of the Kamata reference.

Thus, Kamata is removed as a prior art reference and the Examiner's rejections based on Kamata should be withdrawn.

#### B. The Gryniewich Reference

Claims 1-3, 11-14 and 19-26 stand rejected under 35 U.S.C. 102(e) as

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being anticipated by Grynkevich. Additionally, claims 12, 20 and 21 stand rejected under 35 U.S.C. 103 (a) as being unpatentable over Kamata in view of Grynkevich.

Applicants respectfully submit, however, that Grynkevich can be removed by swearing behind the filing date of the Grynkevich reference.

The Grynkevich reference was filed on April 22, 2003 and issued as a U.S. Patent April 19, 2005. Thus, the earliest effective prior date of the Grynkevich reference is April 22, 2003, its U.S. filing date. Applicants submit that the claimed invention was invented and reduced to practice prior to April 22, 2003. Therefore, the Grynkevich reference is removed by the previous filing of a Declaration under 37 C.F.R. 1.131.

This Declaration under 37 C.F.R. 1.131 (and Exhibit 1 – The Inventor's Original Write-Up of the Invention, Exhibit 2- The Original IBM Internal Disclosure Document, and Exhibit 3 – The MDA Invention Review Board Disclosure) showed invention and actual reduction to practice of the subject matter of the present application prior to the filing date of the Grynkevich reference.

Thus, Grynkevich is removed as a prior art reference and the Examiner's rejections based on Grynkevich should be withdrawn.

#### C. The Klemmer Reference

Claims 16 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kamata in view of Grynkevich and further in view of Klemmer.

As indicated above, the Kamata and Grynkevich references are removed as prior art references.

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Additionally, Klemmer can be removed by swearing behind the filing date of the Klemmer reference.

The Klemmer reference was filed on October 21, 2002 and issued as a U.S. Patent February 1, 2005. Thus, the earliest effective prior date of the Klemmer reference is October 21, 2002, its U.S. filing date. Applicants submit that the claimed invention was invented and reduced to practice prior to October 21, 2002. Therefore, the Klemmer reference is removed by the previous filing of a Declaration under 37 C.F.R. 1.131.

This Declaration under 37 C.F.R. 1.131 (and Exhibit 1 – The Inventor’s Original Write-Up of the Invention, Exhibit 2- The Original IBM Internal Disclosure Document, and Exhibit 3 – The MDA Invention Review Board Disclosure) showed invention and actual reduction to practice of the subject matter of the present application prior to the filing date of the Klemmer reference.

Thus, Klemmer is removed as a prior art reference and the Examiner’s rejections based on Klemmer should be withdrawn.

#### IV. FORMAL MATTERS AND CONCLUSION

In accordance with the Examiner’s objection to the claims, Applicants respectfully submit that dependent claim 13 further limits the subject matter of claim 1. That is, Applicants respectfully submit that claim 1 does not recite “producing a magnetic device”. Indeed, claim 1 clearly recites “a method of patterning a magnetic thin film”. Claim 13 further limits the subject matter of claim 1 by claiming the additional step of producing a magnetic device after the limitation of “transforming a portion of the magnetic thin film to be non-magnetic and electrically insulating using a chemical formation”. A person reasonably skilled in the art would clearly understand what is

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meant by the phrase "producing a magnetic device" and that "producing a magnetic device" is clearly different from "transforming a portion of the magnetic thin film to be non-magnetic and electrically insulating using a chemical formation".

In view of the foregoing, Applicants submit that claims 1-26, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

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The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,

Date: December 28, 2005



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**FACSIMILE TRANSMISSION**

I hereby certify that I am filing this paper via facsimile, to Group Art Unit 2814, at (571) 273-8300, on December 28, 2005.

Respectfully Submitted,

Date: December 28, 2005



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